

**REMARKS**

**Claim Rejections - 35 U.S.C. §102**

**Claims 37 and 38 are rejected under 35 USC §102(e) as being anticipated by Ogura et al. (U.S. Patent No. 6,269,065).**

In the outstanding Office action, the Office has asserted a number of reasons to justify the Office position that a second layer has a higher recording density than a first layer. Specifically, the Office has asserted in its entirety that:

“Ogura et al., according to Figs. 1A-6, shows a recording medium (see Fig. 1A and 1B for example) having a plurality of recording layers (layers L1 and L2), wherein a first data (program) are recorded on one of the recording layers (layer L1) at first recording density (normal data) and data relevant to the first data (same program) are recorded on the other recording layer (layer L2) at a second recording density higher than the first recording density (see column 4, line 18 through column 5, line 50 for information related to density recording and sampling time for first data and relevant data), and the relevant data are higher in quality than the first data and can be played back solely (see Fig. 4) and the relevant data are also sampled at a cycle shorter than that at which the first data have been sampled (see the first data (data recorded on a first generation CD) has a sampling frequency (fs) of 44.1 kHz and the relevant data (data recorded on a second generation CD) has a sampling frequency of 2.8224 MHz or 64fs which is wider than the frequency of the first data, and since the sampling period or cycle is equal to  $1/(\text{sampling frequency})$ , the sampling period or cycle of the relevant data is equal to  $1/(2.8224\text{MHz})$  or  $1/(64\text{fs})$  which is shorter than the sampling period or cycle of the first data which is equal to  $1/(44.1\text{KHz})$ , as recited in claim 37 and 38.”

However, this is merely a position the Office arrived at by inference. Regarding data storage capacity between the first layer and the second layer, column 4, lines 7-11 of Ogura has provided a conclusive position by stating in relevant part that:

“The above-mentioned second generation CD has a diameter of 12 cm and thickness of 1.2 mm and is provided with a double-layered recording area, and has a track pitch of 0.74  $\mu\text{m}$  and a recording capacity of about 4.7 G bytes per one layer,

for a total of about 8.5 G bytes. Furthermore, in an alternative to the above-mentioned disk having a double layered recording area on one side, a disk having a diameter of 12 cm and thickness of 1.2 mm with recording areas on both sides of the disk but with different formats and having a track pitch of 0.74  $\mu\text{m}$  and a recording capacity of the total 9.4 G bytes is also possible as a form of the second generation CD."

Therefore, it is clear from this portion of Ogura that both type of CDs, one having a double layer recording area on one side and another having recording areas on both sides have a track pitch of 0.74  $\mu\text{m}$ . Further, Figure 1B shows that pit P1 and pit P2 have a same length. Based on the above information, Ogura does not show that one recording area and another recording area have different track pitch. If both recording areas have different recording density, Figure 1B should be drawn so as to show that pit P1 would have a different length of pit P2.

Even though the sampling frequency is different between the first layer and the second layer, the recording density depends on physical disk structure. There is not a correlation between sampling frequency.

To more accurately reflect that recording density is different between two layers, claim 37 is further amended to recite:

"wherein the another of the plurality of signal recording layers has a higher data storage density than that of the one of the plurality of signal recording layers."

These features are not disclosed in the asserted prior art.

It is well settled that:

AA claim is anticipated only if each and every element *as set forth in the claim* is found, either expressly or inherently described, in a single prior art reference." *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1567, 7 USPQ2d 1057 (Fed. Cir. 1988)."

Should the Office continue to believe that independent claim 37, as newly amended, is still anticipated by the asserted prior art, a citation of where each and every claimed feature, either as column number and line number, or figure number and reference numeral, or a combination thereof, as disclosed in the asserted prior art is respectfully requested. Should the Office determine that any claimed feature is not disclosed in the asserted prior art, it is respectfully submitted that the claimed invention is not anticipated by the asserted prior art. Allowance of the claimed invention is then respectfully requested.

### **New Claim**

One aspect of the present invention which is not disclosed or taught in the asserted prior art is the fact that the data for the second layer may be recorded at a different position which is not corresponding to where the data is stored in the first layer. This aspect of the present invention is shown by way of examples in Figures 3, 4a, 4b and associated written specification. To ensure these features are accurately reflected in the claim language, independent claim 38 has been amended to recite:

“first data are recorded on one of the plurality of signal recording layers on one semi-circular side, and data relevant to the first data are recorded on another of the plurality of signal recording layer on another semi-circular side;  
the relevant data are higher in quality than the first data and can be played back solely; and

the relevant data are sampled at a cycle shorter than that at which the first data have been sampled;

wherein the another of the plurality of signal recording layers has a higher data storage density than that of the one of the plurality of signal recording layers.”

Nowhere in Ogura et al. is there any disclosure or teaching of these newly added features. Newly added independent claim 39 is patentably distinguished over the asserted prior art. Allowance of this newly added claim is respectfully requested.

**Allowable Subject Matter:**

The allowance of claims 11-15 and 29-32 is noted with appreciation.

**Improper Final:**

Under 706.07(b) Final Rejection, When Proper on First Action [R-1], it is stated that:

“The claims of a new application may be finally rejected in the first Office action in those situations where (A) the new application is a continuing application of, or a substitute for, an earlier application, and (B) all claims of the new application (1) are drawn to the same invention claimed in the earlier application, and (2) would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application.

>A first Office action in a continuing or substitute application may not be made final if it contains a new ground of rejection necessitated by the amendments to 35 U.S.C. 102(e) by the Intellectual Property and High Technology Technical Amendments of 2002 (Pub. L. 107-273, 116 Stat. 1758 (2002)).<

However, it would not be proper to make final a first Office action in a continuing or substitute application where that application contains material which was presented in the earlier application after final rejection or closing of prosecution but was denied entry because (A) new issues were raised that required further consideration and/or search, or (B) the issue of new matter was raised.”

It should be noted that claims 30, 31 32 and 38 were all amended after the Final Office action dated November 25, 2002 was issued. Irregardless whether the Office classified these claim amendments as new issue in the Advisory action, they are issues which were not present before the final Office action. In fact, these were issues only presented after the final Office action was issued. Therefore, they should be regarded as new issues and this Office action should not have been made final. Should the Office believe claim amendments made after a final Office action cannot

Attorney Docket No. 991504  
U.S. Patent Appl. No. 09/446,981  
Page 14

be regarded as new issues, a citation as to where such position is stated in the MPEP is respectfully requested.

Reconsideration and withdrawal of the final Office action are respectfully requested.

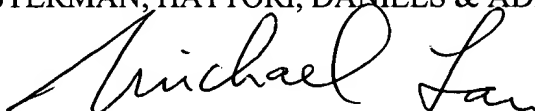
**CONCLUSION**

In view of the aforementioned amendments and accompanying remarks, all pending claims are believed to be in condition for allowance, which action, at an early date, is requested.

In the event that this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 50-2866.

Respectfully Submitted,

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A handwritten signature in black ink, appearing to read "Michael Lau", is written over the printed name.

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